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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,157	01/24/2005	Elmar Kibler	3165-116	9202

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ROTHWELL, FIGG, ERNST & MANBECK, P.C.  
1425 K STREET, N.W.  
SUITE 800  
WASHINGTON, DC 20005

EXAMINER
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BROWN, COURTNEY A

ART UNIT	PAPER NUMBER
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1616

NOTIFICATION DATE	DELIVERY MODE
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12/13/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/522,157	<b>Applicant(s)</b> KIBLER ET AL.	
	<b>Examiner</b> Courtney A. Brown	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/24/2005</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1-32 are pending in the application. Claims 1-32 will be examined on the merits.

### ***Priority***

Priority to PCT/EP2003/007983 filed on July 22, 2003, which claims priority to Provisional Application No. 60/397,618 filed on July 23, 2002 is acknowledged.

### ***Information Disclosure Statement***

Receipt of Information Disclosure Statement filed on January 24, 2005 is acknowledged.

### ***Miscellaneous Remarks***

The examiner notes that Applicant claims a synergistic herbicidal mixture. Examiner notes that component C is an optional component of the herbicidal mixture in independent claim 1; therefore, table 2, pages 30-34 of the specification, are not being evaluated for synergism. Examiner notes tables 3-17, pages 37-46 of the specification, discloses results for component (A), compound Ia.29, and component (B) selected from the group including imazapyr, imazaquin, imazamethabenz-methyl, imazamox, imazapic, and imazethapyr. Compound Ia.29 is a single species in the broad genus that is being claimed in independent claims 1 and 31. A single species cannot show purported unexpectedness of an entire genus. Therefore, the examiner cannot

determine based on a single species that has been tested, if the entire genus would produce the purported synergism when combined with component B. Examiner also notes that in tables 3-17, the percent damage is based on application rates, which changes based on the concentration. It appears that as the application rates and the concentrations change, so will the rate of damage on the undesired crops, i.e. the higher the application rate or the concentration, the higher the damage rate. However, the examiner cannot conclusively determine if the application rates and the concentration have an effect on synergism when compound 1a.29 is combined with component B. Therefore, examiner notes that the claims are not commensurate in scope.

### ***Double Patenting***

Claims 1-32 of this application conflict with claims 1-35 of Application No. 10,522,097. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-35 of Application No. 10522097. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are directed to synergistic herbicidal compositions with the same main component, component A, a 3-heterocyclyl-substituted benzoyl derivative and optional component C which is at least one herbicidal compound selected from the group consisting of at least one of acetyl-CoA carboxylase inhibitors, acetolactate synthase inhibitors, amides, auxin herbicides, auxin transport inhibitors, carotenoid biosynthesis inhibitors, enolpyruvylshikimate 3-phosphate synthase inhibitors, glutamine synthase inhibitors, lipid biosynthesis inhibitors, mitosis inhibitors, protoporphyrinogen IX oxidase inhibitors, photosynthesis inhibitors, synergists, growth substances, cell wall biosynthesis inhibitors or a variety of other herbicides in a synergistically effective amount. Applicant is using open terminology (the term, comprising) which means that anything can be added to the composition. It would be obvious to add another component B, which is also a herbicide. Without any unexpected results on record imparting the addition of component B, the inventions are not patentably distinct.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections- 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-33 are rejected under 25 U.S.C. 102 (b) as being anticipated by Sievernich et al. (CA 2,334,955).

Applicant claims a herbicidal mixture comprising component A, a 3-heterocyclyl-substituted benzoyl derivative, component B, two herbicides selected from the group including imazapyr, imazaquin, imazamethabenz-methyl, imazamox, imazapic, and imazethapyr ( wherein component A and component B are present in a weight ration of 1:0.002 to 1:800), and component C, if desired, at least one herbicidal compound selected from the group consisting of at least one of acetyl-CoA carboxylase inhibitors, acetolactate synthase inhibitors, amides, auxin herbicides, auxin transport inhibitors, carotenoid biosynthesis inhibitors, enolpyruvylshikimate 3-phosphate synthase inhibitors, glutamine synthase inhibitors, lipid biosynthesis inhibitors, mitosis inhibitors, protoporphyrinogen IX oxidase inhibitors, photosynthesis inhibitors, synergists, growth substances, cell wall biosynthesis inhibitors or a variety of other herbicides in a synergistically effective amount. Applicant also claims the herbicidal mixture as defined above wherein there is at least one inert liquid and/or solid carrier, and if appropriate, a

surfactant. Additionally, applicant claims a process for preparation of the herbicidal composition and a method of controlling undesired vegetation.

Sievernich et al. teach a synergistic herbicidal mixture comprising at least one 3-heteroxyxlyl-substituted benzoyl derivative or its environmentally compatible salts and a synergistically effective amount of at least one herbicidal compound from the group of the acetyl-CoA carboxylase inhibitors, acetolactate synthase inhibitors, amides, auxin herbicides, auxin transport inhibitors, carotenoid biosynthesis inhibitors, enolpyruvylshikimate 3-phosphate synthase inhibitors, glutamine synthase inhibitors, lipid biosynthesis inhibitors, mitosis inhibitors, protoporphyrinogen IX oxidase inhibitors, photosynthesis inhibitors, synergists, growth substances, cell wall biosynthesis inhibitors or a variety of other herbicides (page 1, lines 4-40-1a, lines 1-6 and claim 1) (claims 1 and 31, components A and component C; instant invention). Sievernich et al. teach that the most particularly preferred 3-heterocyclyl-substituted benzoyl derivatives include 4-2-[chloro-3-(3-methyl-isoxazol-5-yl)-4-methylsulfonylbenzoyl]-1-methyl-5-hydroxy-1H-pyrazole (page 19, lines 24-26) and 4-[2-methyl-3-(4,5-dihydroisoxazol-3-yl)-4-methylsulfonylbenzoyl]-1-methyl-5-hydroxy-1H-pyrazole (page 20, lines 19-21) (claims 1-7, instant invention). Sievernich et al disclose a synergistic herbicidal mixture of components A and C of the instant application along with component B of the instant application which are acetolactate synthase inhibitors such as imazapyr, imazethapyr, imazapic, imazaquin, and imazamethabenz-methyl (see claim 3). Additionally,



Sievernich et al. disclose a synergistic herbicidal mixture of components A and B ( lipid biosynthesis inhibitors) (component C from the group C9 of the instant application, claims 16-19) such as anilides, chloroacetanilides, thioureas, benfuresate, perfluidone, and acetochlor and photosynthesis inhibitors (group C12 of the instant application, claims 20-26) including benzothiadiazinones such as bentazone and triazines such as atriazine (see claim 3).

Sievernich et al. teach that as a rule, the mixture comprise components A and B in such weight ratios that the synergistic effect takes place( ratios of components A and C of the instant application) in the mixture preferably range from 1:0.002 to 1:800 (page 38, lines 20-24)(claim 28, instant invention) Sievernich et al. teach, in particular, the mixture comprise components A and B2(acetolactate synthase inhibitors) in a weight ratio (ratios of components A and B of the instant application) in the mixture range from 1:0.004 to 1:106, preferably 1:0.006 (page 39, lines 13-40)(claim 27, instant invention). Sievernich et al. further teach that the herbicidal compositions have an herbicidally active amount of a synergistic herbicidal mixture and at least one liquid and/or solid carrier and if desired, at least one surfactant (page 2, lines 8-11) (claims 29 and 30, solid and/or liquid carrier and surfactant, instant invention). Sievernich et al. teach the invention relates to processes for the preparation of the compositions and to a method of controlling undesirable vegetation (page 2, lines 13-15)(claim 31, process of preparation and method of controlling undesired vegetation, instant invention). Sievernich et al. teach that the active ingredients of components A) and B) can be formulated jointly, but also separately, and/or applied to the plants, their environment

and/or seeds jointly or separately (page 37, lines 31-33)(claims 31 and 32, applied to vegetation and/or seeds, instant invention). Sievernich et al. teach it is preferable to apply the active ingredients simultaneously, but it is possible to apply them separately (page 37, lines 33-35) (claim 31, applied simultaneously or in separately, instant invention). Sievernich et al. further teach the mixtures can be applied pre-or post-emergence and that in the case of post-emergence treatment of the plants (page 38, lines 1-2), the herbicidal compositions according to the invention are preferably applied by foliar application (page 38, lines 11-13)(claim 32, mixture and, applied to leaves, instant invention).

None of the claims are allowed.

### ***Conclusion***

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Any inquiry concerning this communication or earlier communications from the

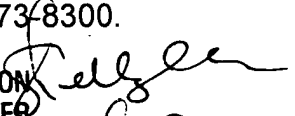

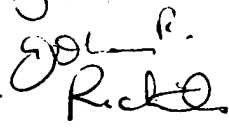
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examiner should be directed to Examiner Courtney Brown, whose telephone number is 571-270-3284. The examiner can normally be reached on Monday-Friday from 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

  
Courtney A. Brown  
Patent Examiner  
AU 1616

  
SHELLEY A. DODSON  
PRIMARY EXAMINER  
  
\_\_\_\_\_  
Johann Richter  
Supervisory Patent Examiner  
  
AU 1616